

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50T5441.01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.6(a)]

on Nov. 22, 2010 - via EFS Web

Signature: /Joanne Ryan/

Typed or printed name: Joanne Ryan

Application Number

10/699,102

Filed

10/31/2003

First Named Inventor

Shuichi Takagi

Art Unit

2159

Examiner

Miranda Le

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.

/Karin L. Williams/

Signature



assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/08)

Karin L. Williams

Typed or printed name



attorney or agent of record.
Registration number 36,721

908-618-7700

Telephone number



attorney or agent acting under 37 CFR 1.34.

11/22/2010

Date

Registration number if acting under 37 CFR 1.34

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.



*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41E. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO 9199 and select option 2.

Reasons for requesting pre-appellate review:

The Rejections Under 35 USC §103(a) are Erroneous

Claims 1-14 and 24-27 are pending in the application. Claims 1-8, 10-14, 24 and 25 were rejected as being unpatentable over Carmel in view of Miller and Grambihler. Claim 9 was rejected as being unpatentable over Carmel in view of Miller and Grambihler in view of Roberts; Claim 26 was rejected as being unpatentable over Carmel in view of Miller and Grambihler in view of Knox; and Claim 27 was rejected as being unpatentable over Carmel in view of Miller and Grambihler and Knox in view of Quinet. (Applicant notes that the Examiner relies upon "Takuchi" at least on pages 20, 21 and 34 of the pending 7/20/10 Final Action (in the section Responding to Applicant's arguments) – yet this reference is no longer RELIED UPON (and was not relied upon in the previous 12/28/09 Action) – clarification is required).

The rejections under 35 U.S.C. 103(a) are erroneous.

The Examiner's reasoning does not meet the burden of establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to *modify the reference* or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined *must teach or suggest all the claimed features*. In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

Applicants respectfully state that the rejection fails because the combined references fail to teach or to suggest all of the elements of the present invention as claimed, and, because there is no suggestion or motivation to combine even the alleged teachings in the manner proposed.

Independent Claim 1 is directed to a method for synchronously transferring an amount of local data from a local data storage medium to a remote data storage medium - the method including selecting a time of day at which to transmit the local data to the remote data storage medium, and automatically arranging transfer of the local data to the remote data storage medium via the communications link at the selected time of day. Independent Claim 14 is an apparatus claim corresponding to method Claim 1 and includes the noted limitation.

As explained in paragraph [0005] of Applicants' specification, as filed, a "typical local PC client has a single processor under independent control, and a limited bandwidth communication link to any remote data storage medium" -- the "local PC may be unable to concurrently perform multiple processing-intensive tasks, such as transferring large data files and running unrelated user applications, and/or data transfers may be slow".

Applicants' proposed method takes these facts into account, by determining if a local processor is idle or has reduced activity, and using that determination (in addition to BOTH the local user conditions and the approximated time for transfer) to select a time of day at which to transmit the local data to the remote storage device. As further explained at paragraph [0029], "the user may specify conditions associated with selection of user data 25, such as, among other conditions: where the data is located; file extensions associated with the data; times, or events, which would trigger transfer of the data; or any combination thereof...the user may request that user data 25 having file extensions such as .DOC or .JPG be transferred immediately, while user data 25 have file extensions such as .MPG or .RM be transferred overnight".

Carmel is directed to a method for "real-time broadcasting from a transmitting computer to one or more client computers -- including 'providing at the transmitting computer a data stream having a given data rate, and dividing the stream into a sequence of *slices*, each slice having a predetermined data size associated therewith".

In Carmel, "data stream 40 comprises a series of data *slices* 42, 44, 46, 48, etc....each slice contains a segment of video and/or audio data, corresponding to a respective, successive time interval labeled T₁, T₂, T₃, etc." (Col. 7, lines 23-25). In addition "time intervals T₁, T₂, T₃, etc are not all equal, but rather are adjusted by computer 34 in response to the transmission rate" (Col. 7, lines 42-45). These "time intervals" are simply time slots, each of which contain a data slice 42, 44, 46, 48, etc. Although these time intervals T₁, T₂, T₃, etc, may be "adjusted by computer 34 in response to the transmission rate" (col. 7, lines 35-49, cited in the Action page 7, lines 1-3), Carmel does not teach (or even suggest) a method that "selects a time of day to transmit local data to the remote data storage medium, and automatically arranges transfer of the local data to the remote data storage via the communications link at the selected time of day."

Carmel does not teach, or suggest in any way the elements recited in Claims 1 and 14, of a method that -- based upon **3 factors** -- (1) the approximated transfer time, (2) the local user

conditions, and (3) the status of the local processor -- selects a time of day at which to transmit the local data to the remote data storage medium, and automatically arranges transfer of the local data to the remote data storage medium at the selected time of day.

The Final Office action takes the position that Carmel implicitly teaches a time of day at which "as in real time" -- and further that Miller teaches the limitation 'selecting a time based on bandwidth' - in Fig. 7, and Table 1 in column 7 (page 8).

Again - in the pending claims, based upon ALL 3 of the RECITED ELEMENTS (the approximated transfer time, local user conditions, and status of the local processor), a TIME OF DAY IS SELECTED, at which the local data will be TRANSMITTED to the remote data storage medium. First, with respect to "(1) the approximated transfer time, ... selecting a time of day at which to transmit the local data to the remote storage medium, Applicant submits that Carmel does not teach or even suggest selecting a time of day (even in 'real time' broadcasting) based upon the approximated transfer time. The "adjustment" of various "time intervals T₁, T₂, T₃, etc", by computer 34 in response to the transmission rate does not provide any teaching of selecting a time of day to transmit data *based upon an approximated transfer time.*

The Action relies upon the alleged teachings of Grambihler as teaching yet another element not explicitly, or implicitly in Applicant's opinion, taught by Carmel - specifically, 'selecting a time of day at which to transmit local data based upon "(2) local user conditions". As detailed in para's [0029]-[0030] of Applicant's specification as filed, a "user may specify conditions associated with selection of user data...such as...where the data is located; file extensions associated with the data; times, or events, which would trigger transfer of the data; or any combination thereof...[f]or example, the user may request that user data 25 having file extensions such as .DOC or .JPG be transferred immediately, while user data 25 have file extensions such as .MPG or .RM be transferred overnight".

Grambihler describes various functions performed by "synchronization manager 60" -- including the "synchronization of local files with network database files 'every Thursday at 11:00 PM'" --- even if this could somehow be read as describing "evaluating local user conditions" -- it simply does NOT suggest "selecting a time of day upon which to TRANSMIT DATA based upon evaluated local user conditions".

Even IF Grambihler teaches *synchronizing* subscriptions – during idle times; and *synchronizing* local files with network database files – every Thursday at 11:00PM --- Grambihler does NOT TEACH OR EVEN SUGGEST selecting a time of day in which local data will be transmitted to a remote storage medium, based upon ALL THREE OF THE SPECIFIC ELEMENTS RECITED IN THE CLAIMS --- Grambihler does NOT teach or even suggest selecting a time of day based upon element (1) – i.e., “the approximated TRANSFER TIME” – COMBINED with elements (2) and (3).

Carmel is very specifically directed to ‘*real-time broadcasting*’ (see e.g., col. 1, lines 50-53, “it is an object of the present invention to provide substantially continuous, high-bandwidth data streaming over a network...” – and also, quoted from col. 2, lines 17-21 of Carmel, “the division of the data stream into slices and the inclusion of the slice indices in the data stream...allows the *broadcast* to go on substantially in *real time*”).

Grambihler’s alleged teachings of ‘scheduling synchronizations’ does not teach or even suggest *evaluating local user conditions in real time and selecting a time of day* in which to transmit local data to a remote storage medium.

In addition, the Action again acknowledges that Carmel and Grambihler do not teach “selecting a time based on bandwidth” and directs Applicant to Miller for such teaching. With respect to the assertions of the teachings and alleged ‘obviousness’ to combine such teachings with those of Carmel and Grambihler, Applicant submits that even *if* Miller describes ‘scheduling data transmission’ from one or more content sources over a network to one or more replicated servers -- it would *not be obvious* to one skilled in the art, in *any way*, to somehow combine such teachings with those of Carmel and Grambihler in the manner suggested in the Action. In fact, again - Carmel very specifically teaches away from any such modification-/combination of teachings –Carmel is specifically directed to ‘REAL-TIME’ broadcasting.

Applicant submits that the *combined teachings* of Carmel, Grambihler and Miller, fail to teach selecting a time of day to transmit local data to the remote storage medium based on (1) the *approximated transfer time*, (2) *local user conditions*, and (3) *status of the local processor*.

For at least the foregoing reasons, Applicants respectfully submit that each of independent Claims 1 and 14 is patentable over the combined teachings of Carmel, Grambihler and Miller.

Dependent Claims 2-13 and 24-27 are also believed to be clearly patentable over the art of record for all of the reasons indicated above with respect to Claim 1, from which they depend, and even further distinguish over the cited references by reciting additional limitations.

Dependent Claim 26 recites that the local user conditions comprise file extensions of the local data. The Action relies upon the alleged teachings of Carmel, Miller, Grambihler and Knox to reject Claim 26. The Examiner takes the position that "Miller implicitly teaches the file extension as criterion" (to select a time of day at which to transmit local data), reciting col. 6, lines 52-59 of Miller, that "the priority level for each content source 12, 14 is assigned based on some criterion...certain content sources 12, 14 may be charged a greater fee by the scheduler..." -- Applicant submits that this does not, in any way, implicitly teach 'using a file extension' as criterion. In addition, even if Knox describes 'analyzing the content of the uploaded data file' (e.g., a *.rm file indicates a file format compatible with the Real Media file structure) -- Knox does *not* teach or suggest selecting a time of day at which to transmit local data based upon a local user condition comprising file extensions of the local data..

Dependent Claim 27 recites that the "local data having a first file extension is transferred immediately and local data having a second file extension is transferred at a later time of day". The Action attempts to arrive at the method of Claim 27, by turning to the alleged teachings of Carmel-Miller-Grambihler-- Knox *and* Quinet, and somehow 'finding' various elements and then *combining* those elements in a manner that would be 'obvious' to one skilled in the art. Quinet's description of "updating priorities" according to a rule wherein "the file extension looks like HTML" to "ensure that a HTML page requested from the bookmarks or typed in directly will be *requested* with a high priority" --does not teach or suggest a method in which a "time of day" is selected based upon local user conditions -- the local user conditions being such that 'local data having a first file extension is transferred immediately and local data having a second file extension is transferred at a later time of day'. This is not taught or suggested by Quinet -- by itself or in any combination with Carmel, Miller, Grambihler and Knox.

Applicant submits that each of the rejections under 35 U.S.C § 103(a) has been obviated and the rejections should be reconsidered and withdrawn.